REMARKS

Claims 1 - 5, 7, 9, 11, 17 - 20, and 22 - 24 have been amended. Claim 26 has been added.

No new matter has been introduced with these amendments or added claim, all of which are

supported in the specification as originally filed. Claims 6, 8, 13, 21, and 25 have been cancelled

from the application without prejudice. Claims 1 - 5, 7, 9 - 12, 14 - 20, 22 - 24, and 26 are now

in the application.

I.   Rejection under 35 U.S.C. §103

Paragraph 2 of the Office Action dated April 21, 2005 (hereinafter, "the Office Action")

states that Claims 1 - 14 and 17 - 25 are rejected under 35 U.S.C. §103(a) as being unpatentable

over Creswell et al. (U.S. 6,775,690) in view of Johnson et al. (U.S. 5,325,310). Paragraph 3 of

the Office Action states that Claims 15 and 16 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Creswell in view of Johnson, and further in view of Lee et al. (U.S.

6,212,553). Claims 6, 8, 13, 21, and 25 have been cancelled from the application without

prejudice, rendering the rejections moot as to those claims. The rejections are respectfully

traversed with regard to remaining Claims 1 - 5, 7, 9 - 12, 14, 17 - 20, and 22 - 24.

Applicants respectfully submit that their independent Claims 1, 7, 18, 20, 22, and 24

contain limitations not taught or suggested by the references, as will now be discussed.

Creswell teaches time-dependent <u>delivery</u> of messages from a processor 41 at a

messaging server 40 to a recipient's communications device 30 when an internal clock 42 at the

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messaging server 40 has a value matching a value in the message. A playback device 60, located at the messaging server 40, "delivers the email message [from the message storage device 50, over communications network 20] to the recipient at communications device 30". (Col. 4, lines 11 - 15.) Time-dependent delivery of a message (also referred to in Creswell as message release) is distinct from time-sensitive rendering of a message, to which Applicants' claims are directed. See, for example, p. 3, lines 9 - 15 and p. 4, lines 8 - 18 of Applicants' specification, which explains (when discussing disadvantages of prior art techniques) that messages, once received by (i.e., delivered to) a recipient, might -- or might not -- be opened with urgency. Thus, while Creswell teaches delivering a message to a recipient according to time-dependent information evaluated at the messaging server (i.e., an analysis and actions undertaken by the messaging server), there is no teaching of requiring any time-sensitive rendering of that message once it has been received at the recipient's computer.

Applicants also respectfully note that the analysis of Claims 1, 18, and 22 does not use the actual claim language of these claims. See p. 2, second bulleted item, which states "such that the marked message is received at a computing device of the recipient within a time period of the time-sensitivity" (emphasis added). This omits several words from the limitations specified in Applicants' claims. The claim language of this limitation (as previously presented) is "such that when the marked message is received at a computing device of the recipient, it will automatically be rendered to the recipient within a time period of the time-sensitivity" (omitted claim language emphasized). The analysis on p. 2 of the Office Action cites col. 4, lines 3 - 18 of Creswell. However, as stated above, this text pertains to the messaging server determining when a message

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should be delivered to a recipient's communications device 30 — not (in contrast to Applicants' claims) to when the message must be rendered. In fact, the Office Action admits that Creswell fails to disclose "that the message will automatically be rendered to the recipient [within the time period of the time-sensitivity]". See p. 2, line of text following third bulleted item.

The Office Action then cites Johnson, col. 3, line 64 - col. 4, line 2 and col. 4, lines 25 - 32 as teaching this limitation. Johnson states therein that the user sending an electronic mail object "may wish to ensure that the recipient views or carefully reads the electronic mail object" (col. 3, lines 64 - 65) and "the sender may mark ... the electronic mail object such that it cannot be exited out of until the appropriate reply has been made" (col. 4, lines 28 - 31).

The Office Action states, in the first paragraph on p. 3, that "a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Creswell et al. by automatically rendering the message to the recipient, such as disclosed by Johnson et al., in order to ensure that the recipient views or carefully reads the message" (emphasis added). However, this supposed motivation uses text from Johnson, not from Applicants' claimed invention, and fails to address the "within a time period of the time-sensitivity" language from Applicants' independent Claims 1, 7, 18, 20, 22, and 24. Applicants respectfully note the holding of the Federal Circuit in *In re Fritch*, 23 USPQ 2d 1780, 1783–84 (Fed. Cir. 1992), which stated:

> "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." (quoting *ACS*

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Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). . . . The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Applicants respectfully submit that the prior art does not teach or suggest "... the desirability of the modification" of Creswell in the manner suggested, in hindsight, by the Examiner, and the supposed motivation is thus in violation of the holding of *In re Fritch*.

Applicants further respectfully submit that – even if Creswell and Johnson were combined (assuming, *arguendo*, that one of skill in the art is motivated to attempt such combination) – the result thereof comprises time-dependent delivery of a message from a messaging server (as per Creswell) and then "requiring a specific response" thereto (as per Johnson; see, for example, lines 5 - 6 and 9 of the Abstract). However, these references fail to teach that the time of the recipient's response is required within a particular period of time. This is in contrast to Applicants' claimed invention, where the response must be "within a time period of the time-sensitivity" of the message.

See also Creswell's Claim 1, which specifies a time-dependent sending of a message to a recipient ("sending said initial time-dependent message to said recipient based on said time code"; col. 6, lines 66 - 67, emphasis added). Notably, each of Creswell's independent claims specifies limitations pertaining to failure of the recipient to receive the message within the predetermined time limit. See, for example, Claim 1 at col. 6, lines 60 - 63 ("and ... if the message is not received by the recipient within the predetermined time limit"); Claim 16 at col.

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7, lines 6 - 8; Claim 18 at col. 8, lines 25 - 27; and Claim 19 at col. 8, lines 46 - 47 ("... if the

message is not made available to the recipient within the predetermined time limit").

This failure of Creswell's recipient to respond within the time-dependency period of a

message is also discussed in the text. Suppose, for example, that Creswell's messaging server 40

determines that a message should be delivered, and provides an "on time" delivery of that

message, yet the recipient chooses to ignore the received message for an arbitrarily-long time.

Col. 5, line 55 - col. 6, line 2 of Creswell discusses this scenario, and teaches that the sender may

have specified other versions of the message, where one of these other versions can be sent after

the initial time-dependent period has passed without receiving a timely acknowledgement from

the recipient. This processing path for Creswell's messages is illustrated in **Fig. 2**, by following

the path through blocks **130** ("no" branch), **140** ("no" branch), **130** ("yes" branch), **160**, **170**

("yes" branch), **180**, and **200** correspond to this scenario. See also col. 4, lines 46 - 57, where the

providing of alternative versions of a message is discussed.

Accordingly, Applicants respectfully submit that their independent Claims 1, 7, 18, 20, 22

and 24, as well as dependent Claims 2 - 5, 9 - 12, 14, 17, 19, and 23, contain limitations not

taught nor suggested by the references, and that any combination of the references fails to

provide these limitations. With regard to Applicants' Claims 15 and 16, Applicants respectfully

submit that these claims are patentable (at least) by virtue of the patentability of independent

Claim 7, from which they depend. The Examiner is therefore respectfully requested to withdraw

the §103 rejection of all remaining claims.
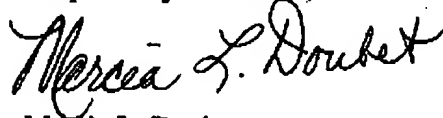
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II.   Conclusion

Applicants respectfully request reconsideration of the pending rejected claims,

withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an

early date.

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